

Appl. No. 10/523,435; Docket No. AT02 0049 US
Amdt. dated October 31, 2006
Response to Office Action dated September 1, 2006

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REMARKS/ARGUMENTS

Claims 1-6 remain pending in the application.

Claims 1 and 5 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as invention.

In response to the §112 rejection, Applicants have amended Claim 1 per Examiner's observations and have included additional language to clarify features of the membrane. The amendment is supported by the Specification and contains no new matter. Refer to Specification (page 4, lines 23-26). Claim 5 has been amended to depend upon amended Claim 1.

The Specification was amended in response to Examiner's observations.

Claims 1 and 2 are rejected under 35 U.S.C. §102(b) as being anticipated by *Bilan et al.* (US 6,243,472B1 hereinafter, "*Bilan*").

Claims 3 and 4 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bilan*.

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Bilan* in view of *Lijima et al.* (US 5,583,945 hereinafter "*Lijima*").

The §102 Rejection

Applicants respectfully assert that Claim 1 (as amended) and dependent Claim 2 are not anticipated by *Bilan*. The device in *Bilan* relates to loudspeakers, and in particular, to eletro-acoustic device of the voice coil variety with built in amplification (col. 1, lines 5-8)." Figures 5-7 of *Bilan* depict the structure of the loudspeaker. Such a structure would find use as an output device for a stereo system.

In contrast with *Bilan*, Applicants' invention finds application for use in "e.g. a mobile telephone or in similar telecommunications apparatuses, which apparatuses need to be especially small. . . (Specification, page 4, lines 12-17)." Furthermore, the feature of "the membrane including an intermediate area adjacent to a U-shaped peripheral area and an annular securing area adjacent to the intermediate area, and a central area located within the annular securing area, said central area serves for sound generation," is not present.

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Consequently, *Bilan* does not anticipate Applicants' invention.

Per MPEP §2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

In view of the foregoing, Applicants respectfully assert that the rejections under 35 USC §102(b) be withdrawn.

The §103 Rejection

With respect to dependent Claims 3 and 4, *Bilan* does not suggest or teach the features of Applicants' invention as presented in the discussion of Claims 1 and 2 *supra*.

Thus, in view of the foregoing, Applicants respectfully assert that the rejections under 35 USC §103(a) be withdrawn for Claims 3 and 4.

With respect to dependent Claim 5, the Office Action states that *Bilan* does not disclose "wherein the circuit module is of a design that can be removed without separate tools," However, the combination with *Iijima* does not make up for this deficiency. *Iijima* refers to a "magnetic circuit" "fixed in the magnetic circuit holding portion (col. 5, lines 9-10)." Applicants assert that this magnetic circuit refers to components directly involved in the functioning of the speaker (i.e., diaphragm 17, damper 18, coil bobbin having a voice coil wound thereon 19, and dust cap 20), unlike the "circuit component" of Applicants' invention. The combination of *Bilan* and *Iijima* is not proper.

Furthermore, to assert a proper §103 rejection, there must be a basis in the art for combining or modifying references, MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

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Thus, in view of the foregoing, Applicants respectfully assert that the rejections under 35 USC §103(a) be withdrawn for Claim 5.

With respect to Claim 6, the modifying of *Bilan* with *Yoo* does not overcome the deficiency of *Bilan*. Applicants respectfully note that the construction of the *Bilan* speaker and the *Yoo* speaker are markedly different. Modifying *Bilan* to be the size of *Yoo* may make a tweeter, as suggested by the Office Action, however the tweeter would quite unlike Applicants' claimed invention. Additionally, the speaker construction of *Yoo* is quite dissimilar to *Bilan*. See Figure 2 of *Yoo* and compare with Figures 5-7 of *Bilan*.

Applicants respectfully assert that one skilled in the art would not combine *Bilan* and *Yoo* to come up with Applicants' invention.

It is established case law that when a §103 rejection is based on a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and a *prima facie* case of obviousness can not be properly made. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification, *In re Gordon*, 7333 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984)"

Thus, in view of the foregoing, Applicants respectfully assert that the rejections under 35 USC §103(a) be withdrawn for Claim 6.

Conclusion

Applicants believe they have addressed all of the Examiner's concerns. A timely Notice of Allowance is hereby requested.

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The Commissioner is hereby requested and authorized pursuant to 37 CFR §1.136(a)(3), to treat any concurrent or future reply in this application requiring a petition for extension of time for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. Please charge any additional fees which may now or in the future be required in this application, including extension of time fees, but excluding the issue fee unless explicitly requested to do so, and credit any overpayment, to Deposit Account No. 50-4019.

Respectfully submitted,

Date: 31-OCT-2006

By Peter Zawilski
Peter Zawilski
Registration No. 43,305
(408) 474-9063

Correspondence Address:

NXP, B.V.
Intellectual Property Department
(formerly Philips Intellectual Property & Standards)
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131 USA

CUSTOMER NUMBER: 65913